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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/668,482	09/25/2000	P. Martin Petkovich	57600/00035	3039

7590 05/25/2004

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EXAMINER

SLOBODYANSKY, ELIZABETH

ART UNIT PAPER NUMBER

1652

DATE MAILED: 05/25/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/668,482

Applicant(s)

PETKOVICH ET AL.

Examiner

Elizabeth Slobodyansky, PhD

Art Unit

1652

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 29 April 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 4 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
- ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:


Claim(s) allowed: _____

Claim(s) objected to: _____

Claim(s) rejected: 83,90 and 113-161.

Claim(s) withdrawn from consideration: _____

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
10. ☒ Other: Interview Summary 18 May 2004


Elizabeth Slobodyansky, PhD
Primary Examiner
Art Unit: 1652

009/668,482

Continuation of 2. NOTE: the scope of the claims has been changed including changes in dependency requiring further consideration and/or search.

Continuation of 5. does NOT place the application in condition for allowance because: for the reasons of record in view of NON-ENTRY of the amendment.

If the amendment were entered, it would overcome the following rejection(s): 112, 1st new matter, of claims 83, 90, 113-157; 112, 1st enablement of claims 116, 120-128, 131-139, 142-147, 149-155, 157, 160, 161; 112, 2nd of claims 83, 90, 113-129, 131-140, 142-148, 150-156, 158-161.

However, claims 114, 115, 118 and 119 would be rejected under 112, 2nd because taken into account the homology between SEQ ID NO:3 and SEQ ID NOs: 5, 31, it is unclear which nucleotide sequences hybridize to both SEQ ID NO:3 and SEQ ID NO:5 or SEQ ID NO:31 under hybridization conditions comprising a wash in 0.2 x SSC at 50 C. If such nucleotide sequences do exist, their representative species are not described in the specification requiring 112, 1st rejections. Furthermore, conceding to the assertion that SEQ ID NO:5 hybridizes to SEQ ID NO:3 under the claimed conditions (see interview summary), would require 102 (b) rejection of claims 83, 90 and 113-157 similar to the one made in the Office action of 2/13/03. This is because the art teaches human protein that is inherently encoded by SEQ ID NO:5 that hybridizes to SEQ ID NO:3 under conditions comprising a wash in 0.2 X SSC at 50 C. Thus, 103 rejection would be converted to 102 rejection absent the new matter limitation.

Claim 129, dependent from canceled claim 128, would be rejected under 112, 2nd as incomplete.

Further, the examiner does not agree that Figs. 11(a,b) provide support for claims 157-161 because there are no defined numbers on the axes and calculations can be made only approximately, i.e. "about six fold", for example. Further, Figs. 11(a,b) refer to the specific COS preparation and not to any microsomal preparation as required by the claims.